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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,440	12/21/2006	Heinrich Ulrich	20793/0204536-US0	9234
7278 DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770	7590 10/09/2009		<div>EXAMINER</div> <div>LAVARIAS, ARNEL C</div>	
			<div>ART UNIT</div> <div>2872</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>10/09/2009</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/573,440

**Applicant(s)**

ULRICH ET AL.

**Examiner**

Amel C. Lavarias

**Art Unit**

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 31-65 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments to the title, abstract, and specification of the instant disclosure in the preliminary amendment filed 3/24/06 are acknowledged and accepted.
2. The cancellation of Claims 1-30 in the preliminary amendment filed 3/24/06 is acknowledged and accepted.
3. The addition of Claims 31-65 in the preliminary amendment filed 3/24/06 is acknowledged and accepted.

### ***Election/Restrictions***

4. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, Claim(s) 32, 62, drawn to a microscope objective and microscope including the microscope objective, further including specifics of the optical fiber configuration for total internal reflection microscopy.

Group II, Claim(s) 33, 46, drawn to a microscope objective and microscope including the microscope objective, further including specifics of the optical fiber being configured to couple illumination light directly into the microscope objective through the optical fiber.

Group III, Claim(s) 34, 47, drawn to a microscope objective and microscope including the microscope objective, further including specifics of the optical fiber being mechanically attached to a portion of the microscope objective.

Group IV, Claim(s) 35-40, 48-53, drawn to a microscope objective and microscope including the microscope objective, further including specifics of the optical fiber having an outcoupling end disposed in a portion of the microscope objective, and further the placement of the outcoupling end being in a particular plane.

Group V, Claim(s) 41-42, 54-55, 59-61, drawn to a microscope objective and microscope including the microscope objective, further including specifics of the optical fiber having an incoupling end configured to have illumination light coupled thereinto so that illumination light exiting from the outcoupling end passes through an optical edge region of the microscope objective.

Group VI, Claim(s) 43-44, 56-57, drawn to a microscope objective and microscope including the microscope objective, further including specifics of the illumination light exit therefrom at an adjustable angle relative to an optical axis.

Group VII, Claim(s) 63, drawn to a microscope objective and microscope including the microscope objective, further including specifics of the illumination light source being configured to emit the illumination light so as to bypass the optical fiber for direct specimen illumination.

Group VIII, Claim(s) 64-65, drawn to a microscope objective and microscope including the microscope objective, further including specifics of a scanning device.

Claims 31 and 45 link Groups I, II, IV, V, VI, VII, and VIII. The features of Claims 31, 35, 45, 48, and 58, which are shown in U.S. Patent No. 6195203, lack novelty or an inventive step and do not contribute over the prior art.

Additionally, Claim 58 will be examined with the elected invention only if one of Inventions IV or V is elected.

5. The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:  
For each of Groups I, II, III, IV, V, VI, VII, and VIII, each of the listed groups has special technical features not required for the other groups. The special technical features exclusive to each group are listed above in the listing of the groups.
6. A telephone call was made to Erik R. Swanson (212-736-1940) on 10/5/09 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 10:00 AM - 6:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arnel C. Lavarias  
Primary Examiner  
Group Art Unit 2872  
10/5/09

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